

ESTTA Tracking number: **ESTTA691951**

Filing date: **08/26/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91223065
Party	Plaintiff PN, LLC
Correspondence Address	Scott Austin VLP Law Group LLP 101 NE Third Avenue, Suite 1500 Fort Lauderdale, FL 33301 UNITED STATES saustin@vlplawgroup.com
Submission	Opposition/Response to Motion
Filer's Name	Scott R. Austin
Filer's e-mail	saustin@vlplawgroup.com
Signature	/Scott R. Austin/
Date	08/26/2015
Attachments	Opposers Opposition to Applicants Motion to Dismiss with Exhibits A through D.pdf(506219 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application
No. 86/256,711 for the mark PN (stylized design)
Application Date: April 18, 2014
Publication Date: April 7, 2015

PN, LLC, a Delaware limited liability company)	
)	
Opposer,)	
v.)	Opposition No. 91223065
)	
C2 Management Group LLC, a Maryland limited)	
liability company)	
Applicant)	
)	
)	

OPPOSITION TO APPLICANT’S MOTION TO STRIKE AND/OR DISMISS OPPOSITION
AND, IF APPLICABLE, MOTION FOR RECONSIDERATION OF ANY EX PARTE
ORDER GRANTING A LENGTHY EXTENSION OF TIME TO FILE OPPOSITION

Opposer PN, LLC (“Opposer”) by and through its attorneys, VLP Law Group LLP, respectfully submits this memorandum in opposition to the motion to dismiss for failure to state a claim under Fed.R.Civ.P. 12(b) (6) and T.B.M.P. §503 filed as Motion To Strike And/Or Dismiss Opposition And, If Applicable, Motion For Reconsideration Of Any Ex Parte Order Granting A Lengthy Extension Of Time To File Opposition by Applicant C2 Management Group LLC (“Applicant”) identified on the Trademark Trial and Appeal Board docket as a Motion to Dismiss: FRCP 12(B) (“Applicant’s Motion”), filed in this proceeding on August 6, 2015 (Docket No. 4) and served upon Opposer by Applicant via First Class Mail.

INTRODUCTION

Applicant’s Motion is neither supported by current law or by reasonable arguments for the extension or reversal of current law. Rather, it is apparent that Applicant filed the motion merely as a

means to delay this proceeding.

Applicant's Motion to strike or dismiss relies on the ground that the Board lacks jurisdiction because Opposer's Notice of Opposition was not timely filed. Applicant lists a hodgepodge of additional ostensible grounds for dismissal on page 2 of its Motion, arguments to which are subsumed under the headings contained herein. Based on the reasons and precedent shown in Part II below, Applicant's argument lacks credibility and is without merit. Opposer's Notice of Opposition was timely filed based on Opposer's valid and timely extension request (Exhibit A attached) approved by the Board (Exhibit B attached), notice of which was made available to Applicant (Exhibit C attached). Accordingly, Applicant's Motion should be denied.

Trademark Rule 2.127 provides that a brief in response to a motion shall be filed within *fifteen days* from the date of service of the motion unless another time is specified by the Trademark Trial and Appeal Board, or the time is extended by stipulation of the parties approved by the Board, or upon motion granted by the Board, or upon order of the Board. The Board's August 1, 2015 order instituting the instant opposition proceeding provides in pertinent part, "Pursuant to Trademark Rule 2.119(c), however, five additional days are afforded only to actions taken in response to papers served by first-class mail." Accordingly, based on the filing date of Applicant's Motion of August 6, 2015 served on Opposer's counsel of record via First Class Mail, this Opposition To Applicant's Motion is timely.

FACTUAL BACKGROUND

1. On May 4, 2015, Opposer timely filed its First 90 Day Request for Extension of Time to Oppose for Good Cause ("Opposer's Extension Request"), setting forth the basis for good cause in the web pages for electronic filing of such extension requests in accordance with the USPTO's Electronic System for Trademark Trials and Appeals or "ESSTA" web site (Exhibit A attached) within the 30-day Publication for Opposition period for Applicants Mark which began on April 7, 2015.

2. On May 4, 2015, the Board issued an order granting Opposer's Extension Request, extending the time to oppose until August 5, 2015 on behalf of potential opposer PN, LLC. (Exhibit B attached).

3. On August 1, 2015, Opposer PN, LLC filed a Notice of Opposition against Application Serial No. 86/256,711 for the mark PN (stylized design) for Applicant's computer consulting services in International Class 42 (Docket No. 1).

4. Opposer alleged in paragraph 1 of its Notice of Opposition, that Opposer PN, LLC, is engaged in providing, amongst other services, computer software and security consulting, as well as computer programming services (Not. of Opp. ¶ 1)

5. Opposer alleged in paragraph 3 of its Notice of Opposition, that it owns the distinctive mark shown in Application No. 86/711,994 (Opposer's PN Mark") for "Computer consultation; Computer consultation in the field of computer security; Computer programming". (Not. of Opp. ¶ 3)

6. Opposer alleged in paragraph 4 of its Notice of Opposition that it has established common law rights in Opposer's PN Mark. (Not. of Opp. ¶ 4)

7. Opposer alleged in paragraphs 2 and 7 of its Notice of Opposition that it has continuously used and promoted Opposer's PN Mark in the United States since at least as early as 2005, well prior to the filing date of Applicant's application now pending on an intent-to use basis under Trademark Act Section 1(b). (Not. of Opp. ¶¶ 2,7).

8. As grounds for opposition, Opposer alleged in paragraphs 7 and 9 of its Notice of Opposition, priority of use and likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). (Not. of Opp. ¶¶ 7, 9)

9. On August 1, 2015, the Board issued an order instituting the instant opposition proceeding, setting forth the schedule for the parties' activities, and adopting the Standard Protective

Order (Docket No. 2).

10. The Board's August 1, 2015 Order specifies the date of September 10, 2015, as the deadline to file an Answer to the Notice of Opposition.

ARGUMENT

A. Standard For Deciding A Motion To Dismiss

For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of the Opposer's well-pleaded allegations must be accepted as true, and its Notice of Opposition must be construed in the light most favorable to the Opposer. *See Stanspec Co. v. American Chain & Cable Company, Inc.* 531 F.2d 563, 189 U.S.P.Q. 420 (C.C.P.A.) 1976). In order to withstand such a motion, Opposer's pleading need only allege such facts as would, if proved, establish that the Opposer is entitled to the relief sought, that is, that (1) the Opposer has standing to maintain the proceeding, and (2) a valid ground exists for denying registration to the pending subject application. *See Lipton Industries, Inc. v. Ralston Purina Co.*, 6670 F.2d 1024, 213 U.S.P.Q. 185 (C.C.P.A. 1982); *Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theatres*, 56 U.S.P.Q.2d 1538 (T.T.A.B. 2000); *Kelly Services Inc. v. Greene 's Temporaries Inc.*, 25 U.S.P.Q.2d 1460 (T.T.A.B. 1992); *Hartwell Co. v. Shane*, 17 U.S.P.Q.2d 1569 (T.T.A.B. 1990). Dismissal for insufficiency is appropriate only if it appears certain that the Opposer is entitled to no relief under any set of facts that could be proved in support of its claim. *See Kelly Services Inc.*, 25 U.S.P.Q.2d at 1462.

B. Opposer Timely Filed Its Notice of Opposition

Opposer timely filed its Notice of Opposition and the request for extension of time in accordance with the Board's ESTTA web site developed for compliance with the applicable

Trademark Rules. As shown in the Exhibits attached:

1. On May 4, 2015, Opposer filed its First 90 Day Request for Extension of Time to Oppose for Good Cause (ESTTA Tracking number: ESTTA670381) within Applicant's 30 day Publication for Opposition Period which ended May 7, 2015 (Exhibit A attached).
2. On May 4, 2015, Opposer received notice that from the Board granting Opposer's request referencing ESTTA Tracking number: ESTTA670381, stating "The request to extend time to oppose is granted until 8/5/2015 on behalf of potential opposer PN, LLC." (Exhibit B attached).
3. On April 7, 2015 the USPTO sent an email under the subject heading "Official USPTO Notice of Publication Confirmation: U.S. Trademark SN 86256711: PN (Stylized/Design)" to the three email addresses designated by Applicant in its application to receive correspondence ("Publication Confirmation Notice"), as shown in Applicant's application prosecution history accessed via the USPTO's Trademark Status & Document Retrieval (TSDR) system (Exhibit C attached).
4. Under the heading "Significance of Publication for Opposition", The Publication Confirmation Notice notified Applicant, as highlighted on the attached Exhibit C for emphasis: "* Any party who believes it will be damaged by the registration of the mark may file a notice of opposition (or extension of time therefor) with the Trademark Trial and Appeal Board. If no party files an opposition or extension request within thirty (30) days after the publication date, then eleven (11) weeks after the publication date a notice of allowance (NOA) should issue." (Exhibit C

attached).

5. In addition, below this asterisked notice, the Publication Confirmation Notice states, "To check the status of the application:" and provides a hyperlink to the online TSDR page showing the status of the application for Applicant's Mark and below the hyperlink states: "Please check the status of the application at least every three (3) months after the application filing date." (Exhibit C attached).
6. On the TSDR page for Applicant's application, clicking on the heading Proceedings immediately reveals the dates and current status information for Opposer's request for extension of time, the Board's grant of that request, and this Opposition Proceeding, of which information Applicant was timely given notice of and access to. (Exhibit D attached).

Thus, there can be no doubt that Opposer's Notice of Opposition was timely filed based on a valid request for extension of time to oppose granted by the Board, and that Applicant received the requisite notice from the Board in accordance with the applicable Trademark Rules, and the Board therefore, has jurisdiction over this opposition proceeding.

C. Opposer Sufficiently Alleged Standing

Beyond the allegations in Applicant's Motion regarding untimely filing, in an abundance of caution Opposer is compelled to address the issue of standing which is often the basis of a motion to dismiss for failure to state a claim under Fed.R.Civ.P. 12(b) (6). There can be no doubt, however, that Opposer has standing and that Opposer sufficiently pleaded standing in its Notice of Opposition. As alleged in the Notice of Opposition:

- Opposer PN, LLC is has priority and continuously used the PN mark: " it has

continuously used and promoted Opposer's PN Mark in the United States since at least as early as 2005, well prior to the Apr. 18, 2014 filing date of Applicant's Application No. 86/256,711 now pending on an intent-to use basis under Trademark Act Section 1(b) (Not. of Opp. ¶¶ 2,7).

- Opposer PN, LLC owns the PN mark in its pending application for registration: “owns the distinctive mark shown in Application No. 86/711,994 (Opposer's PN Mark)” for “Computer consultation; Computer consultation in the field of computer security; Computer programming”. (Not. of Opp. ¶ 3).
- Opposer PN, LLC has established common law rights in the PN Mark: “has established common law rights in Opposer's PN Mark. (Not. of Opp. ¶ 4)
- Opposer PN, LLC is using the PN Mark to identify services substantially similar to the for computer consulting, programming and management services identified in Applicant's application: “engaged in providing, amongst other services, computer software and security consulting, as well as computer programming services (Not. of Opp. ¶¶ 1,6).
- Opposer PN, LLC has priority of use and is being damaged by Applicant's Mark based on likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d): “in view of the fact that the respective marks are essentially identical and the goods and services provided by the respective parties are very similar and in the same International Class 42 it is alleged that Applicant's mark so resembles Opposer's mark in its pending application for registration and as used at common law, as to be likely to cause confusion, or to cause mistake, or to deceive (Not. of Opp. ¶¶ 8,9)

Thus, Opposer's use of its PN Mark in the U.S. at least as early as 2005 precedes any use of a PN mark by Applicant as its application filed April 18, 2014 has been amended to an application for registration based on intent to use.

If Applicant's application is allowed to proceed Applicant's use of the PN mark will cause confusion, mistake or deceive as to the source or origin of goods by creating the erroneous impression that Applicant's services originate with, are sponsored, approved, endorsed, licensed by, affiliated, or associated with, or in some other way legitimately connected to

Opposer, the Opposer's P N Mark or its services. (Not. of Opp. ¶¶ 8,9). Such confusion, mistake or deception by Applicant's use of the P N Mark has and will continue to damage Opposer. (Not. of Opp. ¶¶ 8,9). As a result, Opposer has a real interest in this proceeding and reasonable basis for its belief of damage. *See Kelly Services Inc.*, 25 U.S.P.Q.2d at 1462; *Lipton Industries, Inc.*, 213 U.S.P.Q. at 189.

CONCLUSION

Wherefore, based on the foregoing, Opposer respectfully requests that Applicant's motion to dismiss be denied. In the alternative, Opposer requests that it be permitted to amend its Notice of Opposition if the Board notes any deficiencies.

Date: August 26, 2015

Respectfully submitted,

s:/Scott R. Austin/_____
Scott R. Austin
VLP Law Group LLP
101 NE Third Avenue, Suite 1500
Fort Lauderdale, FL 33301
Telephone: (954) 204-3744
Facsimile: (954) 320-0233
Attorneys for Opposer/Plaintiff PN, LLC

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that the OPPOSITION TO APPLICANT’S MOTION TO STRIKE AND/OR DISMISS OPPOSITION AND, IF APPLICABLE, MOTION FOR RECONSIDERATION OF ANY EX PARTE ORDER GRANTING A LENGTHY EXTENSION OF TIME TO FILE OPPOSITION was filed electronically through the Electronic System for the Trademark Trial and Appeal Board (ESTTA) on this 26th day of August, 2015.

/Scott R. Austin/
Scott R. Austin
VLP Law Group LLP

CERTIFICATE OF MAILING

I hereby certify that a copy of this OPPOSITION TO APPLICANT’S MOTION TO STRIKE AND/OR DISMISS OPPOSITION AND, IF APPLICABLE, MOTION FOR RECONSIDERATION OF ANY EX PARTE ORDER GRANTING A LENGTHY EXTENSION OF TIME TO FILE OPPOSITION is being served on the below opposing counsel/party of record on August 26, 2015, by mailing said copy via First Class Mail, postage prepaid as follows:

SCOTT A. CONWELL, Esq.
CONWELL LAW LLC
2411 CROFTON LN STE 2A
CROFTON, MD 21114-1337

Date of Mailing: August 26, 2015

Printed Name: Scott R. Austin

Signature: /Scott R. Austin/

EXHIBIT A

ESTTA Tracking number: **ESTTA670381**

Filing date: **05/04/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Applicant:	C2 Management Group LLC
Application Serial Number:	86256711
Application Filing Date:	04/18/2014
Mark:	PN
Date of Publication	04/07/2015

First 90 Day Request for Extension of Time to Oppose for Good Cause

Pursuant to 37 C.F.R. Section 2.102, PN, LLC, 102 NE 2nd Street, PMB #171, Boca Raton, FL 33432-3908, UNITED STATES, a limited liability company, organized under the laws of Florida , respectfully requests that it be granted a 90-day extension of time to file a notice of opposition against the above-identified mark for cause shown .

Potential opposer believes that good cause is established for this request by:

- The potential opposer needs additional time to confer with counsel

The time within which to file a notice of opposition is set to expire on 05/07/2015. PN, LLC respectfully requests that the time period within which to file an opposition be extended until 08/05/2015.

Respectfully submitted,

/Scott R. Austin/

05/04/2015

Scott Austin

VLP Law Group LLP

5200 N Federal Highway Suite 2-1081

Fort Lauderdale, FL 33308

UNITED STATES

saustin@vlplawgroup.com

2168707954

EXHIBIT B

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Scott Austin
VLP Law Group LLP
5200 N Federal Highway Suite 2-1081
Fort Lauderdale, FL 33308

Mailed: May 4, 2015

Serial No.: 86256711
ESTTA TRACKING NO: ESTTA670381

The request to extend time to oppose is granted until **8/5/2015** on behalf of potential opposer **PN, LLC**

Please do not hesitate to contact the Trademark Trial and Appeal Board at (571)272-8500 if you have any questions relating to this extension.

Note from the Trademark Trial and Appeal Board

TTAB forms for electronic filing of extensions of time to oppose, notices of opposition, petition for cancellation, notice of ex parte appeal, and inter partes filings are now available at <http://estta.uspto.gov>. Images of TTAB proceeding files can be viewed using TTABVue at <http://ttabvue.uspto.gov>.

EXHIBIT C

From: TMOOfficialNotices@USPTO.GOV
Sent: Tuesday, April 7, 2015 00:28 AM
To: scott@conwellusa.com
Cc: conwellfrontdesk@gmail.com ; mdattorney3000@gmail.com
Subject: Official USPTO Notice of Publication Confirmation: U.S. Trademark SN 86256711: PN (Stylized/Design)

TRADEMARK OFFICIAL GAZETTE PUBLICATION CONFIRMATION

U.S. Serial Number: 86256711
Mark: PN (Stylized/Design)
International Class(es): 042
Owner: C2 Management Group LLC
Docket/Reference Number:

The mark identified above has been published in the Trademark Official Gazette (TMOG) on Apr 07, 2015.

To Review the Mark in the TMOG:

Click on the following link or paste the URL into an internet browser: <https://tmog.uspto.gov/#issueDate=2015-04-07&serialNumber=86256711>

On the publication date or shortly thereafter, the applicant should carefully review the information that appears in the TMOG for accuracy. If any information is incorrect due to USPTO error, the applicant should immediately email the requested correction to TMPostPubQuery@uspto.gov. For applicant corrections or amendments after publication, please file a post publication amendment using the form available at <http://teasroa.uspto.gov/ppa/>. For general information about this notice, please contact the Trademark Assistance Center at 1-800-786-9199.

Significance of Publication for Opposition:

* Any party who believes it will be damaged by the registration of the mark may file a notice of opposition (or extension of time therefor) with the Trademark Trial and Appeal Board. If no party files an opposition or extension request within thirty (30) days after the publication date, then eleven (11) weeks after the publication date a notice of allowance (NOA) should issue. (Note: The applicant must file a complete Statement of Use or Extension Request with the required fees within six (6) months after the NOA issues to avoid abandonment of the application.)

To check the status of the application, go to http://tsdr.uspto.gov/#caseNumber=86256711&caseType=SERIAL_NO&searchType=statusSearch or contact the Trademark Assistance Center at 1-800-786-9199. Please check the status of the application at least every three (3) months after the application filing date.

To view this notice and other documents for this application on-line, go to http://tsdr.uspto.gov/#caseNumber=86256711&caseType=SERIAL_NO&searchType=documentSearch. NOTE: This notice will only become available on-line the next business day after receipt of this e-mail.

EXHIBIT D

STATUS

DOCUMENTS

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Print

Generated on: This page was generated by TSDR on 2015-08-26 13:49:32 EDT**Mark:** PN**US Serial Number:** 86256711**Application Filing Date:** Apr. 18, 2014**Filed as TEAS Plus:** Yes**Currently TEAS Plus:** Yes**Register:** Principal**Mark Type:** Service Mark**Status:** An opposition after publication is pending at the Trademark Trial and Appeal Board. For further information, visit the Trademark Trial and Appeal Board web page.**Status Date:** Aug. 01, 2015**Publication Date:** Apr. 07, 2015▲ **Mark Information**

▼ Expand All

▲ **Goods and Services**▲ **Basis Information (Case Level)**▲ **Current Owner(s) Information**▲ **Attorney/Correspondence Information**▲ **Prosecution History**▲ **TM Staff and Location Information**▲ **Assignment Abstract Of Title Information - Click to Load**▼ **Proceedings****Summary**

▼ Party type

**Number of Proceedings:** 2▼ **Type of Proceeding: Opposition**

▲ Collapse All

Proceeding Number:	91223065	Filing Date:	Aug 01, 2015
Status:	Pending	Status Date:	Aug 01, 2015
Interlocutory Attorney:	GEORGE POLOGEORGIS		
Defendant			
Name:	C2 Management Group LLC		
Correspondent Address:	SCOTT A CONWELL CONWELL LAW LLC 2411 CROFTON LN STE 2A CROFTON MD , 21114-1337 UNITED STATES		
Correspondent e-mail:	scott@conwellusa.com;conwellfrontdesk@g		
Associated marks			
Mark	Application Status	Serial Number	Registration Number
PN	Opposition Pending	86256711	
Plaintiff(s)			
Name:	PN, LLC		
Correspondent Address:	Scott Austin VLP Law Group LLP 101 NE Third Avenue, Suite 1500 Fort Lauderdale FL , 33301 UNITED STATES		
Correspondent e-mail:	saustin@vlpawgroup.com		
Associated marks			
Mark	Application Status	Serial Number	Registration Number
	New Application - Record Initialized Not Assigned to Examiner	86711994	
Prosecution History			
Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Aug 01, 2015	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Aug 01, 2015	Sep 10, 2015
3	PENDING, INSTITUTED	Aug 01, 2015	
4	D MOT TO DISMISS: FRCP 12(B)	Aug 06, 2015	
5	CHANGE OF CORRESP ADDRESS	Aug 25, 2015	
Type of Proceeding: Extension of Time			

Proceeding Number: 86256711		Filing Date: May 04, 2015	
Status: Terminated		Status Date: Aug 05, 2015	
Interlocutory Attorney:			
Defendant			
Name: C2 Management Group LLC			
Correspondent Address: SCOTT A. CONWELL CONWELL LAW LLC 2411 CROFTON LN STE 2A CROFTON MD , 21114-1337			
Associated marks			
Mark	Application Status	Serial Number	Registration Number
PN	Opposition Pending	86256711	
Potential Opposer(s)			
Name: PN, LLC			
Correspondent Address: Scott Austin VLP Law Group LLP 5200 N Federal Highway Suite 2-1081 Fort Lauderdale FL , 33308 UNITED STATES			
Correspondent e-mail: saustin@vlpawgroup.com			
Associated marks			
Mark	Application Status	Serial Number	Registration Number
Prosecution History			
Entry Number	History Text	Date	Due Date
1	INCOMING - EXT TIME TO OPPOSE FILED	May 04, 2015	
2	EXTENSION OF TIME GRANTED	May 04, 2015	